

APPLICANT(S): IDDAN, Gavriel J.
SERIAL NO.: 10/046,540
FILED: January 16, 2002
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REMARKS

The present response is intended to be fully responsive to all points of objection and/or rejection raised by the Examiner and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of the application is respectfully requested.

Applicant asserts that the present invention is new, non-obvious and useful

Status of Claims

Claims 53-76 are pending in the application. Claims 53-76 have been rejected.

Claims 53-71 have been canceled without prejudice or disclaimer. In making this cancellation without prejudice, Applicant reserves all rights in these claims to file divisional and/or continuation patent applications.

Claim Rejections

35 U.S.C. § 102 Rejections

In the office action, the Examiner rejected claims 53, 58, 59, 61-63 and 65- 71 under 35 U.S.C. § 102 as being anticipated by US Patent No. 5,993,378 to Lemelson. Claims 53, 58, 59, 61-63 and 65- 71 have been cancelled without prejudice. The Examiner's rejections to claims 53, 58, 59, 61-63 and 65- 71 under 35 U.S.C. § 102 are therefore moot.

35 U.S.C. § 103 Rejections

In the Office Action, the Examiner rejected claims 53-58, 60-63, 65, 66, 69 and 71- 76 under 35 U.S.C. § 103(a), as being unpatentable over WO 01/53792 A2 to Given Imaging Ltd. ("Given") in light of US Pat. No. 6,330,464 to Colvin, Jr. et al. ("Colvin"). The Examiner also rejected claim 64 under 35 U.S.C. § 103(a), as being unpatentable over Given in view of Colvin and further in view of US Pat. No. 6,498,941 to Jackson

Claims 53-58, 60-63, 64, 65, 66, 69 and 71 have been cancelled without prejudice. The Examiner's rejections of claims 53-58, 60-63, 64, 65, 66, 69 and 71 under 35 U.S.C. § 103(a) are therefore moot.

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Applicant respectfully traverses the rejection of claims 72 -76 under 35 U.S.C. § 103(a) based on Given in view of Colvin.

Applicant asserts that neither Given nor Colvin, teach or suggest an "interaction chamber being behind an optical window" as is required in Applicant's independent claim 72. In the office action, the Examiner writes that "The imager and interaction surface are considered to be positioned behind an optical window in that the optical window (53) extends to the left of both the interaction surface (52) and the imager (55) (Figures 7 and 8)." However, contrary to the Examiner's understanding of Given, Given teaches that "In accordance with the invention any reactant 52 as described above can be immobilized onto the viewing window 53, which is transparent to the illuminating light. The reactant 52 is immobilized as described above to a band 54 on the viewing window 53." (page 11, line 29-32) This statement in Given clearly indicates that the reaction chamber in Given is not "behind an optical window" as is required in Applicant's independent claim 72, but rather set on the outside of the optical window. The drawing in Fig. 7 of Given shows a band of reactant 52 that is on or wrapped around the window such that the window is visible in the figure both to the right and the left of the window. Applicant asserts that no reasonable reading of "behind an optical window" could refer to a reactant placed on the outside of the window. Applicant therefore asserts that neither Given nor Colvin, alone or in combination, teach or suggest the invention of independent claim 72.

An obviousness rejection requires a teaching or a suggestion by the relied upon prior art of all the elements of a claim (M.P.E.P. §2142). Since neither Given nor Colvin teach or suggest all the elements of independent claim 72, the Examiner fails to establish a prima facie showing that Given or Colvin, alone or in combination, teach or suggest every feature of claim 72. Applicant therefore asserts that independent claim 72 is allowable and respectfully requests the Examiner to remove the rejection to claim 72 under Section 103.

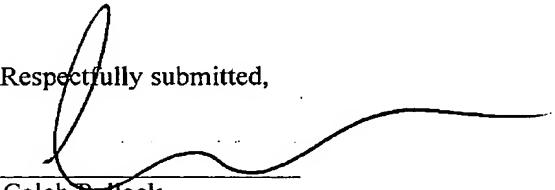
Dependent claims 73-76 depend from independent claim 72 and therefore include all of the elements of such independent claim. Since claim 72 is allowable, Applicant asserts that each of dependent claims 73 -76 are likewise allowable. Their favorable reconsideration and allowance is respectfully requested.

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Should the Examiner have any question or comment as to the form, content or entry of this Amendment, the Examiner is requested to contact the undersigned at the telephone number below. Similarly, if there are any further issues yet to be resolved to advance the prosecution of this application to issue, the Examiner is requested to telephone the undersigned counsel.

Please charge any fees associated with this paper to deposit account No. 50-3355.

Respectfully submitted,


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